

Remarks

Claims 1-10, 12-21, 24, 27, 28, 32, and 34-36 are pending.

Rejections Under 35 U.S.C. § 103

Claims 1, 10, 12, 14, 15, 17, 24, 27, 32, 34, and 35 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent 5,797,898 to Santini Jr. et al. (hereinafter "Santini") in view of U.S. Patent Application Publication No. 2004/0121486 to Uhland et al. (hereinafter "Uhland"), in further view of U.S. Patent 5,660,846 to Cheikh (herein after "Cheikh"). Claims 2-9, 13, and 16 were rejected under 35 U.S.C. § 103(a) as obvious over Santini, in view of Uhland, in further view of Cheikh, and in further view of Rubin et al., "The Potential of Parathyroid Hormone as a Therapy for Osteoporosis," *Int. J. Fertil.* 47(3):103-15 (2002) (hereinafter "Rubin"). Claims 18-21 and 36 were rejected under 35 U.S.C. § 103(a) as obvious over Santini, in view of Uhland, in further view of Cheikh, and in further view of U.S. Patent No. 6,011,011 to Hageman (hereinafter "Hageman"). Claim 28 was rejected under 35 U.S.C. § 103(a) as obvious over Santini, in view of Uhland, in further view of Cheikh, and in further view of U.S. Patent 6,294,390 to Barnard et al. (hereinafter "Barnard"). The rejections are respectfully traversed, based on the following Statement of Common Ownership Pursuant to MPEP §706.02(I)(2)(II).

Statement Of Common Ownership Pursuant to MPEP §706.02(I)(2)(II):

The present Application No. 10/654,761 and Uhland were, at the time the invention of Application No. 10/654,761 was made, both owned by MicroCHIPS, Inc. Thus, Uhland does not constitute prior art pursuant to 35 U.S.C. § 103(c), as detailed below.

35 U.S.C. § 103(c) states that “[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

Uhland is only prior art under 35 U.S.C. § 102(e). Uhland has a filing date of August 15, 2003, and a publication date of June 24, 2004. The present application was filed on September 4, 2003.

The inventive entities of the present application and Uhland are different. *See* M.P.E.P. §2136.04. Specifically, the inventive entity of Uhland is Uhland, Polito, Maloney, Sheppard, Herman, and Yomtov. The inventive entity of the present application as currently named is Ausiello, Santini, Herman, and Prescott.

The present application and Uhland were owned by the same person and/or subject to an obligation of assignment to the same person at the time the invention of the present application was made. The present application has been assigned to MicroCHIPS, Inc. (See assignment recorded on November 5, 2003, with the USPTO at Reel 014101, Frame 0599). Uhland also has been assigned to MicroCHIPS, Inc. (See assignment recorded on November 12, 2003, with the USPTO at Reel 014121, Frame 0752).

In view of the foregoing, Applicants therefore assert that, under 35 U.S.C. § 103(c), Uhland is not available as a prior art reference to the present claims. Claims 1-10, 12-21, 24, 27, 28, 32, and 34-36 are patentable over any combination of Santini, Cheikh, Rubin, Hageman, and/or Barnard.

Santini

Santini discloses multi-reservoir devices for passively or actively controlled drug delivery. Santini describes, for example, active disintegration of reservoir caps by an *electrochemical* mechanism. Santini does not disclose or remotely suggest the *electrothermal* ablation technique or structures therefor.

Cheikh, Rubin, Hageman, and Barnard

Cheikh discloses miniature delivery devices and pen-like injection devices for use with solid drug compositions. Cheikh fails to remotely suggest a device that has utilizes electrothermal ablation to disintegrate reservoir caps to initiate release of PTH, as required by Applicants' claims.

Rubin also fails to remotely suggest a device that has utilizes electrothermal ablation to disintegrate reservoir caps to initiate release of PTH. Furthermore, one skilled in the art would not have been motivated to combine the teachings of Santini and Rubin in light of Rubin's teaching away from the use of an implantable medical device for administration of PTH.

Hageman discloses protein formulations that include polyethylene glycol as an excipient. Nothing in Hageman supplements the deficiencies of the teachings of Santini and Cheikh. For instance, nothing in Hageman remotely teaches electrothermal ablation of a reservoir cap to initiate release of parathyroid hormone from a reservoir.

Barnard discloses immobilized compounds for use as active components in sensors. Barnard also fails to remotely suggest a device that has utilizes electrothermal ablation to disintegrate reservoir caps to initiate release of PTH.

Conclusions

Prompt allowance of each of the pending claims 1-10, 12-21, 24, 27, 28, 32, and 34-36 is therefore respectfully solicited. The undersigned kindly invites the Examiner to contact him by telephone if any outstanding issues can be resolved by conference or examiner's amendment.

Respectfully submitted,

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